

## **REMARKS/ARGUMENTS**

Claims 1-4, 6-12, 14-18, 20, 21, 23 and 24 are pending in the present application. Claims 1, 2, 9, 10, 15, 16 and 21 have been amended, and Claims 5, 13 and 19 have been cancelled, herewith. The listing of the claims beginning on page 2 of this response replaces all prior versions, and listings, of claims in the application.

### **I. 35 U.S.C. § 103, Obviousness**

Claims 1, 3, 5-9, 11, 13-15, 17, 19, 20 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over IBM Technical Disclosure Bulletin NNRD455178, published March 2002, hereinafter “IBM” and Goldstein et al. (U.S. Publication No. 2003/0221167), hereinafter “Goldstein”. This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to Claim 1, such claim recites, “displaying, in response to receiving another user input selecting the selected browser window command from the menu of commands, a list of currently active browser windows including an indication of a presently displayed document in each respective browser window in the list of currently active browser windows”. As can be seen, a list of currently active browser windows is displayed *in response to receiving user input selecting a selected browser window command*. In addition, this ‘list’ of currently active browser windows includes an indication of a presently displayed document in ‘each’ respective browser window in the ‘list’ of currently active browser windows.

In rejecting this aspect of Claim 1, the Examiner alleges that Goldstein in combination with IBM teaches such displaying of a ‘list’ and its associated characteristics at Goldstein Figure 8 and paragraph [0096], and IBM 2<sup>nd</sup> paragraph. Applicant urges clear error in such assertion, as will now be shown in detail.

First, and contrary to the Examiner’s assertion on page 4 of the Final Office Action dated May 27, 2010, Goldstein does not teach displaying “a list of currently active browser windows”. Instead, Goldstein teaches displaying a list of open ‘custom selection’ windows – and these ‘custom selection’ windows *are not all active browser windows*, but instead are a subset of user created windows containing customized content (Goldstein paragraphs [0082] and [0089], et seq.). In contrast, Claim 1 is directed to displaying a list of all active browser windows. Applicant has amended Claim 1, as further described below, in order to further emphasize this distinction. Thus, for this reason alone it is urged that Claim 1 has been erroneously rejected due to such *prima facie* obviousness deficiency.

Second, and contrary to the Examiner’s assertion on page 3 of the Final Office Action dated May 27, 2010, IBM does not display “an indication of a presently displayed document in *each* respective browser window in the *list* of currently active browser windows” (emphasis added by Applicant). Instead, IBM teaches that when a user positions a pointer over *one of the ICONs*, a popup will display the URL/title of a *single window*. This is different from what is recited in Claim 1 since per the teachings of IBM, (i) there is no ‘list’, nor (ii) any display of an indication of a presently displayed document in *each* respective browser window in the *list* of currently active browser windows. Thus, it is further urged that Claim 1 has been erroneously rejected due to these additional *prima facie* obviousness deficiencies.

Still further with respect to Claim 1, Applicant has amended such claim to include the features previously recited in Claim 5 (which is thus being cancelled herewith, without prejudice or disclaimer). As amended, Claim 1 recites, “concurrently displaying, in response to receiving another user input selecting the selected browser window command, from the menu of commands, a list of currently active browser windows including an indication of a presently displayed document in each respective browser window in the list of currently active browser windows, wherein the list of currently active browser windows, including the indication of the presently displayed document in each respective browser window in the list of browser windows, that is concurrently displayed is a list consisting of all currently active browser windows”. As

can be seen, amended Claim 1 is directed to further characteristics of the ‘list of currently active browser windows’, where such list is a list of *all currently active* browser windows.

In rejecting Claim 5 (whose features are now a part of amended Claim 1), the Examiner alleges that the 2<sup>nd</sup> paragraph of IBM teaches all aspects of Claim 5 since there it describes ‘The browser is designed to have one or more ICON’s each representing a browser window’.

Applicants urge that these IBM ICONs are not a list of *all currently active* browser windows because IBM states that the browser will open a new window browser window if this is a first operation (IBM 2<sup>nd</sup> paragraph, lines 16-20) – and therefore such ICONs do not represent a *currently active* browser window (since it has to be newly opened). Quite simply, the IBM ICONs do not provide any type of currently active status indication – since the *identical icon can represent both an unopened and opened window* (and therefore there is no list that consists of currently active browser windows), and thus these ICONs do not teach or suggest “wherein the list of currently active browser windows, including the indication of the presently displayed document in each respective browser window in the list of currently active browser windows, that is concurrently displayed is a *list consisting of all currently active browser windows*” (emphasis added), as claimed. Thus, it is urged that Claim 1 is non-obvious in view of the cited references.

The features of amended Claim 1 advantageously provide an ability to quickly and easily see a list of all currently active browser windows with a single user selection (the ‘another user input’), whereas per the teachings of the combined references, not only would a user have to mouse-over-hover-over an individual ICON to see if it is representing a currently active window, or alternatively, is not representing a currently active window since it has not yet been initialized, as previously shown, but in addition the user would have to mouse-over-hover-over each particular ICON one at a time to identify all currently active browser windows. Thus, amended Claim 1 is now in condition for allowance.

Applicant traverses the rejection of Claims 3 and 6-8 for reasons given above with respect to Claim 1 (of which Claims 3 and 6-8 depend upon).

Applicant traverses the rejection of Claims 9, 11, 13-15, 17, 19, 20 and 23 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1, 3, 5-9, 11, 13-15, 17, 19, 20 and 23 under 35 U.S.C. § 103 has been overcome.

## **II. 35 U.S.C. § 103, Obviousness**

Claims 2, 10 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over IBM, Goldstein and Soper et al. (U.S. Publication No. 2004/0085293), hereinafter “Soper”. This rejection is respectfully traversed.

Applicant initially traverses the rejection of Claim 2 (and similarly for Claims 10 and 16) for reasons given above with respect to Claim 1, as the newly cited reference to Soper does not overcome the prima facie obviousness deficiencies identified hereinabove.

Further with respect to Claim 2 (and similarly for Claims 10 and 16), such claim has been amended to recite “promoting the browser window to a top of a window hierarchy such that the browser window is subsequently used when displaying another new document when the current browser window command is selected during a subsequent opening of the another new document”. As can be seen, the ‘promoting’ aspect of Claim 2 has been further defined, whereby the same browser window, per the user selection of Claim 1, is used when subsequently opening another window using the current browser window command. It is urged that the cited reference to Soper merely describes that a currently selected window becomes the front or active window. Thus, it is further urged that amended Claim 2 (and similarly for Claims 10 and 16) is now in condition for allowance.

Therefore, the rejection of Claims 2, 10 and 16 under 35 U.S.C. § 103 has been overcome.

## **III. 35 U.S.C. § 103, Obviousness**

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over IBM, Goldstein, Soper and Wishoff (U.S. Publication No. 2002/0051017), hereinafter “Wishoff”. This rejection is respectfully traversed for reasons given above with respect to Claim 1, as the newly cited reference to Wishoff does not overcome the prima facie obviousness deficiencies identified hereinabove.

Therefore, the rejection of Claim 24 under 35 U.S.C. § 103 has been overcome.

**IV. 35 U.S.C. § 103, Obviousness**

Claims 4, 12 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over IBM, Goldstein and Ludolph et al. (U.S. Patent No. 6,133,898), hereinafter “Ludolph”. This rejection is respectfully traversed for reasons given above with respect to Claim 1, as the newly cited reference to Ludolph does not overcome the prima facie obviousness deficiencies identified hereinabove .

Therefore, the rejection of Claims 4, 12 and 18 under 35 U.S.C. § 103 has been overcome.

**V. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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